

REMARKS

Claims 1-8 and 17-45 are pending. Claims 9-16 have been canceled, without prejudice or disclaimer. Claims 1-8 and 17-26 are unamended, and new claims 27-45 have been added to further define different embodiments of the invention. These new claims are not necessitated by any prior art. Support for the new claims is found in the specification and drawings, and no new matter has been added. Applicant requests reconsideration of the original claims, and consideration of the new claims, in light of the following remarks.

Applicant notes that the outstanding office action is dated approximately 2½ years after Applicant's most recent amendment. Applicant requests that the prosecution for this application be conducted in the most expeditious manner possible on the part of the Patent and Trademark Office in order to grant Applicant's assignee, Owens Corning, patent rights to combat copying of Applicant's invention by Owens Corning's competitors. Such copying is described in Applicant's Declaration, as explained below.

In the outstanding office action, the Examiner rejected claims 1-2, 9-10, 17-18, and 25-26 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,369,929 to Weaver et al. (hereinafter, "Weaver") in view of U.S. Patent No. Des. 417,513 to Blanpied (hereinafter, "Blanpied"). Applicant contends that all the claims are patentable over the combination of the Weaver and Blanpied references, and requests withdrawal of the rejection under 35 U.S.C. §103.

Weaver discloses a laminated roofing shingle having an overlay with wide cutouts and wide tabs. The tabs are not rectangular, but rather are cut with slanted sidewalls in a trapezoidal shape. As disclosed in Figs. 6 and 7, the process used to make Weaver's shingle includes cutting complementary shingles in an interdigitized manner, thereby assuring that the surface area of the tabs approximately equals the surface area of the cutouts. This means that the cutouts do not have a relatively narrow width relative to the width of the tabs. Consequently, Weaver's shingles could

not possibly simulate a plurality of adjacent slate roof tiles. Weaver's abstract describes the tabs as being of a relatively uniform color, and the exposed portion of the underlay having a vertical color gradient. Weaver's drawings plainly show that adjacent segments or sections of the lower portion, when viewed horizontally across the shingle, alternate between the tabs 36 of relatively uniform color and the exposed underlay having a color gradient showing through the cutouts 38. See Fig. 2 of Weaver. It is clear that Weaver depends on the differentiation between these adjacent segments or sections to achieve his desired look, and that modifying Weaver's shingle by narrowing his cutouts so that they were relatively narrow with respect to the tabs would strip Weaver of an essential element of his shingle, i.e., a contrasting section of exposed color gradient positioned between tabs of relatively uniform color. Accordingly, Weaver by itself does not anticipate or make obvious Applicant's claims.

Blanpied discloses a shingle design in which the butt or lower portion of the shingle includes a plurality of differently shaded segments or sections arranged horizontally across the horizontal width of the shingle. Presumably, these differently shaded segments or sections represent different colors. Some of the color segments or sections are approximately rectangular. Some of the designs shown in Blanpied show the butt portion of the shingle being divided into three tabs by two narrow cutouts that are narrowly defined relative to the width of the tabs. Others of Weaver's designs have no cutouts, and therefore no tabs. In the designs where the shingle has tabs defined by cutouts, each tab has at least three sections or segments, presumably representing three different colors.

Blanpied's designs do not show or suggest that the color blend for each tab is to be substantially uniform in color. Having a substantially uniform color blend for each tab would go against the clear disclosure of Blanpied's design, as disclosed in the drawings, since he shows multiple colors on each tab. Further, Blanpied's tabs do not provide the appearance of a slate roof tile, and neither his shingles, nor a roof covering of his shingles would provide the appearance of a plurality of adjacent slate roof tiles.

Accordingly, Blanpied by itself does not anticipate or make obvious Applicant's claims.

The rejection of claims 1-2, 9-10, 17-18, and 25-26 is based on a combination of the Weaver and Blanpied references.

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP §2143.

With respect to claims 1 and 17, the rejection fails to meet the third criterion of a *prima facie* case because although Weaver's tabs are relatively uniform in color, there is nothing to suggest that a tab of Weaver's shingle would have a different color blend from a tab of a different shingle when laid on a roof with other substantially identically shaped shingles in overlapping longitudinal courses. Blanpied adds nothing to Weaver other than to make the tabs have multiple color segments. Since the third criterion of a *prima facie* case is not met, the claims 1 and 17 are patentable over the combination of Weaver and Blanpied. For at least this reason, all the claims dependent on claims 1 and 17 are also patentable. Accordingly, Applicant requests withdrawal of the rejection of claims 1-8 and 17-27 based on 35 U.S.C. §103(a).

Further, the first criterion of a *prima facie* case is not met. There would be no motivation to modify Weaver with Blanpied since making this substitution would

defeat the purpose of Weaver by removing the sections of color gradient, which Weaver says provide his shingle with a "desired illusion of depth or thickness", as stated by Weaver in his abstract. Also, combining the tabs of Weaver, having a relatively uniform color, with Blanpied's tabs, which each have at least three colors, would frustrate Blanpied's design of showing multiple colors on each tab.

Accordingly claims 1 and 17 are patentable over the combination of Weaver and Blanpied. For at least this reason, all the claims dependent on claims 1 and 17 are also patentable. Accordingly, Applicant requests withdrawal of the rejection of claims 1-8 and 17-27 based on 35 U.S.C. §103(a).

As further evidence of the non-obviousness of Applicant's invention, Applicant is supplying with this amendment a Declaration in which the Applicant sets forth various facts pertaining to the commercial success of a shingle product sold by Owens Corning, the Assignee of the present application, and made according to one embodiment of the present invention. In the declaration, the Applicant states that the Owens Corning Berkshire® shingles have enjoyed wide success in the marketplace, and that an Owens Corning competitor, CertainTeed Corporation, has copied the concept underlying the invention.

In addition to the rejection of claims based on the combination of Weaver and Blanpied, the Examiner also rejected various dependent claims under 35 U.S.C. §103(a) as being unpatentable over Weaver and Blanpied when combined with additional references, such as the references of record to Stapleton, Phillips and Bondoc '329. Since independent claims 1 and 17 have been shown to be patentable over the references, their respective dependent claims are also patentable.

With respect to independent new claims 27, 33, 39, 43, and 45, Applicant submits that there would be no motivation to modify Weaver's shingle, which has a pattern of contrasting exposed underlay sections of color gradient positioned between tabs of relatively uniform color, by substituting Blanpied's multiple sections of color to replace Weaver's underlay sections of a color gradient. Nothing in either reference

would motivate such a substitution. Making this substitution would defeat the purpose of Weaver by removing the sections of color gradient, which Weaver says provide his shingle with a "desired illusion of depth or thickness". See Weaver's abstract.

Further, combining the tabs of Weaver, having a relatively uniform color, would be at odds with Blanpied's tabs which each have at least three colors. The first criterion of a *prima facie* case of obviousness is not met since there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to combine reference teachings. Since this first criterion is not met, the claims are not obvious, and, accordingly, claims 27, 33, 39, 43, and 45 are patentable over the combination of the Weaver and Blanpied references. For at least this reason, all the claims dependent on claims 27, 33, 39, 43, and 45 are also patentable.

Further, the second criterion of a *prima facie* case of obviousness pertaining to new independent claims 27, 33 and 43, and new dependent claim 40, would also not be met by the combination of Weaver and Blanpied. The second criterion is that the applied references must teach or suggest all the claim limitations. Claims 27, 33, 40, and 45 provide that the color blend for each tab is substantially uniform in color, and that each cutout has a width that is sufficiently narrowly defined relative to the width of the tabs so that the lower portion of the shingle simulates a plurality of adjacent slate roof tiles. Accordingly, at least for this additional reason, claims 27, 33, 40, and 45, and any claims dependent on those claims, should also be patentable over the combination of Weaver and Blanpied.

In view of the above amendments and remarks, Applicant has shown that the invention, as defined in the claims, is neither disclosed nor suggested by the references of record. Accordingly, Applicant respectfully requests reconsideration of claims 1-8 and 17-26, as well as consideration of new claims 27-45, withdrawal of the rejection of record, and allowance of all claims.